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Application No.: 09/892,318
Office Action Dated: 03/29/2006

PATENT



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

**In re Application of:
R. Abburi et al.**

Application No.: 09/892,318

Filing Date: 06/27/2001

**For: Enforcement Architecture And Method For Digital Rights Management
System For Roaming A License To A Plurality Of Users**

Confirmation No.: 1941

Group Art Unit: 2136

Examiner: Eleni Shiferaw

DATE OF DEPOSIT: July 28, 2006

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Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Applicant respectfully requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The review is requested for the reasons stated on the attached sheets. No more than five pages are provided.

REMARKS

I. Reasons for Review

Withdrawal of the Final Rejection, dated 3/29/2006, is believed appropriate for the following reasons: The Examiner erred by fabricating teachings that are not disclosed in the references. The Examiner also erred in not explicitly finding all of the recited claim elements in the cited references. The Examiner also erred in combining two incompatible references such that their impermissible combination is not sufficient to render the claims prima facie obvious per MPEP §2143.01 Part VI.

II. Status of Prosecution

All Claims in the present application are rejected. No claims were amended in the final response. Claims 1, 5, 8, 16-17, 23-24 and 26 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Story, Jr. et al. (U.S. Publ No. US 2002/0046181 A1) in view of Benson et al. (U.S. Patent No. 6,678,665 B1) and Hurtado et al. (U.S. Patent No. 6,418,421 B1) and in further view of Biddle et al. (U.S Patent Publication No. US 2002/0107809 A1). Claims 1, 12, 16, 17, and 24 are independent claims and are rejected under the 4-way combination of Story et al., Benson et al., Hurtado et al. and Biddle et al. All other claims are dependant upon the independent claims.

III. Claim elements alleged in references are not actually taught.

One element of Claim 1 is “receiving a second key pair associated with a second of said plurality of devices, said second key pair being different from said first key pair” The key pair being an encryption key pair. The Examiner generated a rejection by stating on page 4-5 of the final rejection dated 3/29/2006 that “Story Page 4 Claim no. 3; second digital license is stored in the second device; and Page 4 par. 0052, digital license stored in the device is encrypted and it is obvious that the second device receives the second key pair different from the first key pair because it would prevent an authorized copy of digital content”. Although Story et al. teaches “encryption” in paragraph 0052, Applicant notes that Story et al. completely lacks any teaching of encryption keys. Applicant submits that the Examiner has erred by fabricating or assuming a teaching of encryption keys that is not

actually found in the cited reference. Story et al. simply has no teaching of encryption keys or of a first and second key pair of any kind.

Applicant also finds that Story et al. teaches generating a different cardinality (See Abstract), but not a different encryption key tied to each of the playback devices.

Accordingly, Applicant also concludes that there is no teaching of separate encryption mechanisms for playback devices taught by in Story et al. This is in distinction to the claims which recite elements including a different key pair for a first and second device. (Refer to Applicant response dated 5/26/2006, page 8.)

IV. All claim elements are not found in the references.

Claim 1 recites, in relevant part, “creating a second digital license bound to said second device using said second key pair, said second digital license being based on said first digital license”. On page 5 of the final office action dated 3/29/2006, the Examiner states “However Benson teaches generating a public and private key pair and the first key pair is associated with the second key pair (Benson Col. 11 lines 66-col. 12 lines 23)”. The Examiner continues with “Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the teachings of Benson with in the system of Story because it would allow to locate a certificate that holds the associated digital signature public keying material and then the software vendor may potentially execute some administrative action (Benson Col. 12 lines 24-37).” Applicant notes that Claim 1 recites no “association” between the first key pair and the second key pair as asserted by the Examiner. No Claim 1 element recites an association between a first key pair and a second key pair. Claim 1 also recites no digital signature certificate, no software vendor, and no “potential” execution of an unspecified administrative action. Consequently, the Examiner cited Benson for a purpose unrelated to any claim limitation. More importantly, the Examiner failed to explicitly address how Benson teaches the Claim 1 element of “creating a second digital license bound to said second device using said second key pair, said second digital license being based on said first digital license”. Whereas the Examiner found an association between a first key pair and a second key pair, that association is not part of the recited claim element which associates digital licenses. (Refer to Applicant response dated 1/18/2006, pages 8-10).

V. No prima facie case of obviousness with the cited references.

The teachings of the combination of references of Story et al. and Hurtado et al. are not sufficient to render the claims prima facie obvious per MPEP §2143.01 Part VI because the addition of Hurtado et al. to Story et al. impermissibly changes the principle of operation of Story et al. by separating the digital license from the digital content as widely taught and thoroughly claimed in Story et al.

MPEP §2143.01 Part VI states that a proposed modification cannot change the principle of operation of a reference in a 35 U.S.C. §103 rejection. Specifically, Part VI states: “If the proposed modification or combination of the prior art would change the principle of operation of the prior art being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.”

Applicant notes that Story et al. teaches that the digital license is included in the digital content (Abstract, Figure 6, Figure 7, paragraph 0005, 0051, 0052, and Claims 1, 11, and 21). Applicant notes that the storing of the license into the digital content is not only taught often in Story et al., it is also an element in every independent claim of Story et al. (See Claims 1, 11, and 21). Applicant concludes that this is a major operational principle of Story et al. Also, Story et al. teaches that playback devices store multiple licenses, which allows playback devices to belong to multiple sets of playback devices authorized to play back various digital content. (Abstract). Applicant submits that this multiple license storage aspect is also an important principle of operation of Story et al. because it too is taught in the specification and is recited in every independent claim (Claims 1, 11, and 21) of Story et al.

Hurtado et al. teaches a system for tracking usage of digital content on user devices such that the digital content is transferred in a Content SC (Secure Container) and the digital license is contained in a separate License SC (See Figure 1D, items 148 and 147 respectively). Applicant notes that these two SCs are separate entities (See also items 602 and 660 of Figure 6). Thus, the digital content and the digital license are purposefully separate in Hurtado et al.

Applicant submits Hurtado et al. teaches that the separate entities of the Content SC and the License SC are not combined. Specifically, the License SC is not stored in the Content SC as is taught in the specification and claims of Story et al. It was noted above that the storage of the digital license into the digital content was so important to Story et al., that it

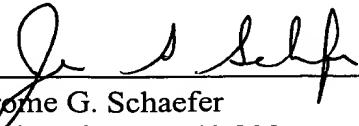
was not only recited multiple times in the specification, but it was also placed in every independent claim of the Story et al. invention. Applicant submits that the addition of Hurtado et al., with its separate license and digital content aspect, into the invention of Story et al., with its claimed combined license and digital content, would change the principle of operation of Story et al. because it changes the way the end user device of Story et al. has to store and use digital content and a digital license.

In as much as the architecture of Hurtado et al. keeps the Content SC and the License SC as separate items, yet Story et al. teaches and claims digital content and digital licenses are specifically combined, the two references are fundamentally incompatible and thus not combinable under MPEP §2143.01 Part VI because the combination impermissibly changes the operation of Story et al. and thus cannot be a viable combination for purposes of establishing a *prima facie* case of obviousness under 35 U.S.C. §103(a). (Refer to Applicant response dated 5/26/2006. pages 8-10).

VII. Conclusion

Accordingly, Applicant respectfully submits that the 35 U.S. C. §103 (a) rejection of all pending claims does not represent a valid *prima facie* case of obviousness because all elements are not present in the references and the combination is impermissible according to MPEP §2143.01 Part VI. Applicant submits that this applies to the 35 U.S.C. §103 (a) rejection of independent Claims 1, 12, 17 and 24 and all of their respective dependent claims. Thus, all pending claims patentably define over the cited art. Applicant earnestly requests a Notice of Allowance for all pending claims.

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